

MAR 26 2003

Technology Center 2600

manager. A switched virtual circuit is established for the session between the first access control manager and the second access control manager.

Claim 12 is directed to a method for providing quality of service in an IP telephony session between a calling party and a called party. The method includes the steps of assigning a temporary IP proxy address to the called party at a first access control manager. A temporary IP proxy address is assigned to the calling party at a second access control manager. A temporary second network calling party address is assigned for said session at said first access control manager. Finally, a temporary second network calling party address is assigned for said session at said second access control manager.

Johnson is directed to a small office communications system, a full PBX type telecommunications system 50 that supports both voice and data communications. See col. 1, line 57- col. 2, line 63, and col. 2, line 66 – col. 3, line 60. The heart of the PBX system 50 is host processor 70. See col. 7, lines 16-20, col. 8, lines 16-26 and col. 8, lines 55-58. As shown in Figure 2, communications system 50 is coupled to the telephone network via digital trunks 54 and POTS (plain old telephone service) trunks 54. Internally, system 50 is coupled to file server 20, printer 22, work station terminals 24, telephone sets 12, and Fax machine 44. The file server employs Dynamic Host Configuration Protocol (DHCP) to assign IP addresses to workstation computers 24.

According to **MPEP 2131**, “to anticipate a claim, the reference must teach every element of the claim.” A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As stated above, to anticipate a claim, the reference must teach every element of the claim. Johnson is not on point because it is directed to PBX office equipment, whereas the present invention is directed to IP network telephony. Johnson does not teach every element of the claim. In particular, Figure 3 of Johnson does not include an ATM network, as the Examiner suggests. For example reference numeral 82, which includes a box labeled “ATM,” refers to an interface card. See col. 10, lines 21-37. Reference 79b and 79c, which are also labeled “ATM,” also refer to plug-in cards. See col. 10, lines 46-56. Contrary to the Examiner’s assertions, Johnson does not disclose a method for providing quality of service between a called party and a calling party because Johnson is not directed to networking callers over a network. Instead, Johnson discloses a single PBX system. Johnson also does not teach or suggest access control managers that are configured to assign temporary IP proxy

addresses as recited in claim 5 and claim 12. Johnson also does not disclose the establishment of a switched virtual circuit for an IP telephony session between two access control managers as recited in claim 5. Johnson also does not assign temporary calling party addresses for each session, as recited in claim 12.

Response to Arguments

The Examiner states in his office action that Applicant's arguments are moot in light of the new grounds of rejection. However, the Applicant notes that the Examiner's rejection of claims 5 – 19 is identical to the rejection issued in the previous office action. The Applicant responded with detailed arguments explaining why the Examiner failed to make a prima facie case of anticipation. The Examiner never responded to the Applicant's arguments. The Applicant respectfully points out that the Examiner has a duty to respond to all of the Applicant's arguments.

For the above reasons, the applicant respectfully asserts that claims 5-19 are patentable under 35 U.S.C. § 102(e).

2. § 103 Rejections

A. The Examiner has rejected claims 1, 2, 4, and 20-23 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,081,513 [Roy] in view of U.S. Patent No. 5,828,844 [Civanlar et al., hereinafter Civanlar]. The Applicant respectfully traverses the rejection because the Examiner has failed to make a prima facie case of obviousness because the Examiner has failed to show where each element of the claimed invention is found in the cited references. Further, the Examiner has failed to provide a proper motivational statement for combining the references.

Claim 1 is directed to a method for providing quality of service in an Internet Protocol (IP) telephony session between a calling party and a called party. The method includes the step of transporting IP telephony media for the session between the calling party and a first device. The first device has IP telephony capability and ATM capability. IP telephony media for the session is transported between the called party and a second device. The second device also has IP telephony capability and ATM capability. An ATM virtual circuit is established for the session between the first device and the second device. The data path for the telephony session is secured by the use of proxy addressing. The step of securing the data path by proxy addressing is described in great detail on pages 5 – 7, and also shown in detail in Figure 2.

Claim 20 is directed to a system for providing a quality of service IP telephony session between a calling party and a called party. The system includes an IP telephony network. The IP telephony network provides IP telephony access to the calling party and to the called party. The system also includes an ATM network. A first device is connected between said IP telephony network and said ATM network. The first device provides bi-directional translation between IP media traffic and ATM traffic. A second device is connected between said IP telephony network and said ATM network. The second device provides bi-directional translation between IP media traffic and ATM traffic. An intelligent control layer establishes a virtual circuit through said ATM network for an IP telephony session between the calling party and the called party, whereby the first device and the second device are assigned on a per session basis.

Roy is directed to a wide area network that includes the interconnection of customer premise LANs via an ATM wide area network. Routers are disposed between the IP networks and the ATM network. The routers are configured to encapsulate the IP packets to transfer the data over the ATM network. The configuration of Roy is very similar to the arrangement described in the background section of the present invention. The problem associated with Roy, and with the approach discussed in the background of the invention, is that (1) possible destination IP addresses need to be provisioned in the router ahead of time, and, (2) it is not possible to define which IP flow should get the ATM service and which should get the IP best efforts service. In other words, when a destination address is provisioned in the router, then all traffic to that destination address will be carried by the ATM virtual circuit.

Civanlar discloses a system and method for establishing communications over a client-server network using internet protocol (IP) switches. Civanlar discloses a network that is comprised of IP switches that are configured to operate using both IP and ATM protocol (See Figure 3, col. 5, line 59 – col. 6, line 9). Clients may employ dial-up services, or may directly access the IP switches (See Figure 3, col. 5, lines 62 – 67). Clients may request special services by accessing a proxy-server. The proxy server is typically a Web-server that is administered by an Internet Service provider (Col. 6, lines 10 – 15). The client accesses the web-server by using a web-browser that is secured by a password. Once access is secured, the client “conveniently selects the service attribute from a list provided on the browser” (Col. 6, line 15 – 20). For example, the client may select ATM services, non-ATM services, dial-

up services, ISDN services, an IP address of an Internet host, an Intranet name, billing numbers, credit card information, or filter information (Col. 6, lines 21 – 34).

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1.) The Examiner fails to point out where all of the claim limitations are taught or suggested in the cited references.

The Examiner fails to make a *prima facie* case of obviousness because he fails to point out where all of the claim limitations are taught or suggested in the cited references. With respect to claims 1, 2, 4, and 20-23, the Examiner does not point out where either Roy or Civanlar expressly or inherently describe each and every element as set forth in the claims. Referring to page 3, paragraph 4, of the office action, the Examiner's rejection consists of a general statement that does not specifically refer to any of the claim elements. Subsequently, the Examiner states that "Civanlar teaches the proxy server for protecting information, which exchanges between devices and provider to specify client characteristics or desired service attributes." The Examiner does not explain the relevance of this statement to any of the elements recited in the claims.

As pointed out in the Applicant's last response, while Roy describes the interconnection of customer premise LANs via an ATM wide area network, Roy does not disclose the step of securing a data path for the telephony session by the use of proxy addressing, as recited in claim 1. Further, Roy does not disclose an intelligent control layer that establishes a virtual circuit through said ATM network by assigning the first device and the second device on a per session basis, as recited in claim 20. Civanlar does not provide any of the missing features. Civanlar teaches a Web-server that is accessed by clients to select desired service attributes (col. 6, lines 14 – 20).

2.) There is no suggestion in the cited references or in the knowledge generally available to one of ordinary skill in the art to combine the references.

As stated above, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner states that “it would have been obvious to a person of ordinary skill in the art at the time of the invention was made [sic] to implement the proxy scheme into Roy for securing in the communication network and establish QoS guarantees for the communication.” There is no prima facie case for obviousness because the Examiner has failed to point out where in the references this suggestion can be found. Alternatively, the Examiner has failed to point out where the suggestion can be found in the knowledge generally available to one of ordinary skill in the art. Further, the Examiner’s reason for combining the references is impermissible hindsight. Applicant respectfully submits that the Examiner’s statement for combining the references is a restatement of the Applicant’s claimed invention (see preamble of claim 12 and claim 20) and the field of the invention stated in the Background of the Invention (See first paragraph of the Background section). The U.S. Court of Appeals for the Federal Circuit has emphasized that the Examiner cannot employ hindsight when combining references. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

For the above reasons, the applicant respectfully asserts that claims 1-4 and 20-24 are patentable under 35 U.S.C. § 103(a).

B. The Examiner has rejected dependent claims 3 and 24 under 35 U.S.C. § 103 as being unpatentable for obviousness over Roy and Civanlar in view of Johnson. The Applicant respectfully traverses the rejection because the Examiner has failed to make a prima facie case of obviousness because the Examiner has failed to show where each element of the claimed invention is found in the cited references. Further, the Examiner has failed to provide a proper motivational statement when combining the references.

1.) The Examiner fails to point out where all of the claim limitations are taught or suggested in the cited references.

Claim 3 depends from claim 1. Claim 24 depends from claim 20. As discussed above, the Examiner has failed to show where the combination of Roy and Civanlar disclose all of the claim elements of claim 1 and claim 20. Thus, the combination of Roy, Civanlar, and Johnson cannot have all of the limitations of claim 3 and claim 24.

Claim 3 and claim 24 are also allowable in their own right because neither Roy, Civanlar, nor Johnson teach or suggest the subject matter recited by claim 3 and claim 24.

Each reference was discussed above in detail. The Examiner asserts that the Dynamic Host Configuration Protocol (DHCP), disclosed in Johnson, teaches the subject matter of claim 3 and claim 24 (See col. 8, lines 3 – 13). The Applicant argues that Johnson is not on point because Johnson refers to the dynamic allocation of IP telephony devices, such as computers and telephones, in a PBX. Johnson teaches a PBX that accommodates a plurality of internal office communication devices with a limited number of output ports. These devices are time multiplexed using the dynamic allocation of output IP addresses. However, the claimed invention is completely different.

For example, the Examiner has failed to show that the combination of Roy, Civanlar and Johnson teaches a first device and a second device, each having IP telephony capability and ATM capability, the first device being identified by a temporary IP proxy address for a called party and the second device being identified by another temporary IP address for a calling party, whereby an ATM virtual circuit is established between the first device and the second device, as recited in claim 3. With respect to claim 24, the Examiner has likewise failed to show that the combination of Roy, Civanlar and Johnson teaches a first device and a second device, each providing bi-directional translation between IP media traffic and ATM traffic, the first device being identified by a temporary IP proxy address for a called party and the second device being identified by another temporary IP address for a calling party, such that an intelligent control layer establishes an ATM virtual circuit between the first device and the second device.

2.) There is no suggestion in the cited references or in the knowledge generally available to one of ordinary skill in the art to combine the references.

Again, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Examiner states that “it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to adopt the known teaching of DHCP in the system of Roy for providing IP address assignment, thereby enhancing the system with higher capacity and security.” Once again, the Examiner fails to show where this rationale can be found in either the prior art or in the knowledge generally available to one of ordinary skill in the art. The notion that the combination of a hybrid WAN (Roy), a client-server network (Civanlar), and a PBX system (Johnson), is suggested by any one of the references, or by the knowledge generally available to those of ordinary skill in the art strains the limits of credulity.

For the above reasons, the applicant respectfully asserts that claim 3 and claim 24 are patentable under 35 U.S.C. § 103(a).

Conclusion

Based upon the above remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1-24 and a prompt Notice of Allowance thereon.

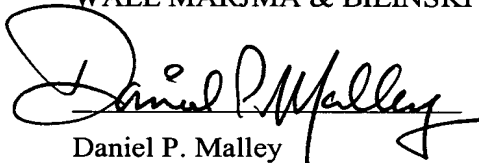
Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to WorldCom Deposit Account **13-2491**.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

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